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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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CAHN & SAMUELS LLP 2000 P STREET NW SUITE 200 WASHINGTON, DC 20036				
			EXAMINER PICH, PONNOREAY	
			ART UNIT 2135	PAPER NUMBER

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/060,310

Applicant(s)

CLARK, PAUL C.

Examiner

Ponnoreay Pich

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The examiner notes that in response to the election/restriction requirement made on 5/31/2006, applicant elected the invention of group I (claims 1-10 and 13) without traverse, whereby claims 11, 12, and 14 were cancelled and no new claims were added. Any well known art statements made in the prior office actions not specifically and adequately traversed by applicant are taken as admittance of prior art as per MPEP 2144.03. Claims 1-10 and 13 are pending. Note that any new objections or rejections made in this office action are in response to amendments by applicant.

Response to Amendment

The examiner notes that claim 6 was amended in the Response submitted on 6/30/2006. The examiner further notes that amendments to the specification were made by applicant. In the office action of 5/31/2006, the examiner suggested that applicant amend claim 6 such that "a computer readable storage medium" was recited in the claim instead of "computer usable medium" because the specification defined computer **usable** medium as encompassing a signal, i.e. carrier wave, and it is current Office policy that claims to a signal are not patentable. On the other hand, "computer **readable storage** medium" was not defined by the specification and it is Office policy wherein if such a medium was **not** defined in the specification, when examining the claim for 101 issues, applicant is given the benefit of the doubt and it is assumed that the medium was not mean to encompass a signal. The examiner notes that applicant made use of the examiner's comments and amended claim 6 as recommended. However, applicant also amended the specification such that now, the term "computer

readable storage medium” is defined and encompasses a signal, i.e. carrier wave. As such, not only has applicant’s amendment to the specification introduced new matter to the specification, but claim 6 must also be rejected under 35 USC 101 despite applicant incorporating the examiner’s suggestion of claim amendment. Note that canceling the latest amendment to paragraph 30 of the specification will overcome the new matter objection to the specification and the 101 rejections to the claims.

The rest of the comments made below concerning amendments are directed towards amendments submitted by applicant on 3/22/2006 in which an election/restriction office action was sent by the Office.

It is noted that paragraph 29 of the specification was amended to add the sentence “[a]n exemplary logical unit is depicted in Figure 5”. The examiner respectfully submits that this appears to be new matter as before the amendment was made, the specification described what is seen in Figure 5 as “a standard PC”. In fact, paragraph 15 of the specification still describes what is seen in Figure 5 as a block diagram of a “standard PC”. Thus, it appears that applicant’s specification now describes Figure 5 as disclosing two different items. It is unclear what Figure 5 is meant to disclose. The examiner assumes based on what was originally disclosed in the specification that Figure 5 shows a standard PC and not an exemplary logical unit as is now recited in paragraph 29. Note that something that is a *standard* implies that it is prior art and as such, Figure 5 should have a Prior Art label as only that which is old is disclosed. Clarification by applicant concerning this issue is respectfully requested.

It is noted that the examiner previously objected to paragraph 52 of the specification because there should be a space between 10 and could in the second line. Applicant indicated that paragraph 52 should be replaced, but what replaces it has no amendment. It is assumed that applicant meant to insert the space as recommended by the examiner.

Response to Arguments

Applicant's arguments submitted on 3/22/2006 and directed towards art rejections of the pending claims have been fully considered, but are not persuasive.

Applicant argues as per claim 1 that Dickenson does not teach "receiving an encrypted data transmission over an outbound proxy from a security client disposed in the first domain and determining whether the data transmission is recognized prior to transmitting the data transmission". As per claim 6, applicant's arguments are Dickenson does not disclose code that causes a first logical unit to determine whether an enhanced data transmission is recognized. The examiner respectfully disagrees with the arguments for both claims. Citations of where Dickenson meets the argued limitations are provided below as well as further explanations.

Specification and Drawings

The specification and drawings (Figure 5) are objected to for the reasons discussed above. Applicant is required to cancel any amendments which introduced

new matter to the specification. In addition, clarification by applicant regarding Figure 5 and what is disclosed in the specification concerning Figure 5 is respectfully requested.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 and 13 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claim 1 recites "the data transmission" which lacks antecedent basis. The examiner assumes that each recitation of "the data transmission" in claim 1 should instead be "the encrypted data transmission".
2. Claims 3-5 and 13 recite "the data transmission". It is unclear of which data transmission is being referred to in each claims as claim 1 from which the claims depend refer to more than one data transmission, i.e. an encrypted data transmission and the decrypted data transmission.
3. Claim 13 recites "the outbound proxy" and "the security client" both of which lacks antecedent basis.
4. Any claims not specifically addressed are rejected by virtue of dependency.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Art Unit: 2135

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 6-10 are directed towards an article of manufacture comprising a computer readable storage medium having program code. As applicant has amended the specification such that computer readable storage medium now encompasses a signal, i.e. carrier wave, claims 6-10 are not statutory because it is the Office's current view that claims to a signal are not statutory. Note that canceling the amendment to paragraph 30 would not only overcome the new matter objection to paragraph 30 of the specification, but it would also overcome this 101 rejection. As explained above, when a type of medium is not explicitly defined in the specification, it is the Office's current policy to give applicant the benefit of the doubt and assume that the medium is not meant to cover a signal. The examiner assumes that the amendment to claim 30 was by accident and that applicant did not mean for a computer readable storage medium to encompass a signal, i.e. carrier wave. Comments by applicant are respectfully requested to clarify record.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2135

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 13, 6-7 and 9-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Dickenson, III et al (US 6,609,196).

Claim 1:

Dickenson discloses:

1. Receiving an encrypted communication over an outbound proxy from a security client disposed in the first domain (Fig 1; col 2, lines 35-48; and col 8, lines 47-65). *Note that email firewall 105.1 encrypts emails sent from email network 101 and sends it over the outbound proxy, items 106.1, 104, and/or 106.2. Email firewall 105.2 receives the encrypted email. This reads on the first limitation recited.*
2. Identifying a sender of the encrypted data transmission using a personal identifier associated with the encrypted data transmission (col 2, lines 35-48 and col 8, lines 12-22).
3. Determining whether the sender is authorized to perform the encrypted data transmission (col 2, lines 59-col 3, line 7 and col 8, lines 12-22).
4. Determining whether the encrypted data transmission is recognized (col 2, line 59-col 3, line 11). *Dickenson discloses use of a mail filters in the firewall which prevents unauthorized email messages from being sent. Recognized emails, i.e. recognized encrypted data transmissions, are sent. The firewall also has*

exceptions for filter rules for messages from certain users. This implies identification/recognition of encrypted data transmission belonging to certain users.

5. Decrypting the encrypted data transmission if it is determined that the encrypted data transmission is recognized and the sender is authorized to perform the encrypted data transmission (col 2, line 58-col 3, line 7; col 8, lines 12-22 and lines 48-56).
6. Transmitting the decrypted data transmission to an application server disposed in the second domain (col 8, lines 48-56 and Fig 5A-5C). *One skilled should appreciate that the manner in which email are sent from one user to another is that a first user composes an email message, which gets sent to their email server. This first server then forwards the message to the recipient's email server and the recipient's email server forwards it to the recipient's email client. As such, after email firewall 105.2 (Fig 1) decrypts the received email, it forwards the decrypted email to the email (application) server located in email network 103.*

Claim 2:

Dickenson further discloses the personal identifier is one of a biometric or digital signature (col 8, lines 12-22).

Claim 3:

Dickenson further discloses determining whether the sender is authorized to perform the data transmission includes checking an access control list to determine the sender's privilege level (col 2, line 59-col 3, line 7 and col 8, lines 12-22).

Claim 4:

Dickenson further discloses preventing the data transmission from reaching the application server if it is determined that the data transmission is not recognized and the sender is not authorized to perform the data transmission function (Fig 6a-6b; col 2, line 59-col 3, line 7; and col 8, lines 12-22).

Claim 5:

Dickenson further discloses enhancing data prior to sending the data transmission (col 8, lines 48-65).

Claim 13:

Dickenson further discloses wherein determining whether the data transmission is recognized includes comparing proxies contained in said first logical unit to the outbound proxy of the security client (col 7, line 44-col 8, line 7).

Claim 6:

Claim 6 is directed towards an article of manufacture comprising a computer readable storage medium comprising computer readable program code that causes a first logical unit to perform the method as recited in claim 1. Claim 6 is rejected for substantially the same reasons given in claim 1.

The examiner has interpreted the encrypted data referred to in claim 1 to be the same as the enhanced data of claim 6 and the de-enhanced data transmission of claim 6 to be the same as the decrypted data transmission of claim 1. One skilled should appreciate that because Dickenson's invention is computer implemented, an article of manufacture comprising a computer readable storage medium comprising code to perform the method as recited in claim 1 is inherent to Dickenson's invention since modern computers requires code stored in a medium to determine functionality of the computers. The first logical unit recited in claim 6 is email server 105.2 seen in Figure 1 of Dickenson, which is discussed above as performing the method of claim 1.

Claim 7:

Dickenson further discloses wherein the data in the enhanced data is encrypted (col 2, lines 35-38).

Claim 9:

Dickenson further inherently discloses computer readable program code for causing the first logical unit to determine a privilege level of the sender by searching an access control list that contains the sender's privilege level (col 2, line 59-col 3, line 7 and col 8, lines 12-22). Note Dickenson discloses that certain users may be exempted from some filter rules. This implies that there exists a way to identify those users, i.e. an access control list, and which rules they are exempt from.

Claim 10:

Dickenson further inherently discloses program code for preventing the data from reaching the third logical unit if it is determined that the sender is not authorized to

Art Unit: 2135

transmit the data (col 2, line 59-col 3, line 7 and col 8, lines 12-22). Note that Dickenson discloses that if only certain users are exempt from filter rules. If the messages aren't to be sent according to the filter rules, the messages are prevented from transmitting.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dickenson, III et al (US 6,609,196).

Claim 8:

Dickenson does not disclose wherein enhanced data includes biometrically secured data. However, data being biometrically secured was well known in the art at the time applicant's invention was made. It would have been obvious to one of ordinary skill in the art to have modified Dickenson's invention such that enhanced data includes biometrically secured data. One of ordinary skill would have been motivated to do so as biometrically secured data are typically more secure than ones secured using other

Art Unit: 2135

types of computer generated keys and it allows the user of the system to not have to remember the encryption key or carry around an encryption token.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Fri.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2135

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ponnoreay Pich
Examiner
Art Unit 2135

PP


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